

### REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 12 and 15-26 are pending in this application, Claims 12 and 17 having been currently amended; and Claims 25 and 26 having been added. Support for amended Claims 12 and 17 can be found, for example, in the original claims, drawings, and specification as originally filed.<sup>1</sup> No new matter is added.

In the outstanding Office Action, the drawings and specification were objected to due to informalities; Claims 12 and 15-24 were rejected under 35 U.S.C. § 112, first paragraph; Claims 12, 14-19, 21, and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi et al. (U.S. Patent No. 6,859,535; hereinafter “Tatebayashi”) in view of Chan et al. (U.S. Patent No. 6,226,237; hereinafter “Chan”); Claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi and Chan in view of Schneier (Applied Cryptography Second Edition); Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi and Chan in view of Jones et al. (U.S. Patent No. 6,697,944; hereinafter “Jones”); and Claim 24 was rejected under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi and Chan in view of Boothroyd et al. (U.S. Patent No. 5,267,123; hereinafter “Boothroyd”).

In regard to the rejection of Claims 12 and 15-24 under 35 U.S.C. § 112, first paragraph, pages 3-4 of the outstanding Office Action state that “the newly added claim limitation reciting ‘transferring copyrighted music data to the external storage card even if power of said central processing unit is turned off’ appears to lack support in the original specification. The applicant’s have pointed to portions of the specification as showing support for this limitation. However, in these sections, as well as the remainder of the

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<sup>1</sup> See page 19, lines 17-23 of the specification.

specification, the examiner is only able to find support for reproducing (i.e. playing) music content when the CPU is not powered.” Applicant’s respectfully submit that the feature of “said power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off and when said external storage card has been cross-authenticated with said general-purpose computer, said external storage card control mechanism transfers copyrighted music data to said external storage card even if power of said central processing unit is turned off,” is adequately supported in the specification and drawings as originally filed.

Initially, Applicants note that compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, ***expressly or inherently***, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. (Emphasis Added). *In re Mott* 539 F.2d 1291, 190 USPQ 536, 541 (CCPA 1976). The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow* 707 F.2d 1366, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Page 19, lines 3-6 of the specification states that the “power controller 73 supplies power to the memory card drivers 151-1 and 151-2 and the sound controller 64 even if the power to the personal computer 1 is off.” In addition, page 21, lines 1-8 of the specification states that:

Because the power is kept supplied from the power controller 73 to the memory card driver 151-1 and the sound controller 64 independently via the USB interface 68 when the power to the personal computer 1 is off, the memory card driver 151-1 reads the music data from the loaded memory card 21-1 on the basis of the signal inputted from the jog lever 12-1, decodes the read

music data, and sounds the decoded music data. (Emphasis Added).

Page 19, lines 10-23 of the specification further states that:

The I/O interface 69 executes the LED monitor program 70A, the pointing device input monitor program 70B, the key input monitor program 70C, the wake-up program 70D, and the *jog dial monitor program 70E* on the internal power supply *even if the power to the personal computer 1 is off. Namely, these programs are always operating.*

Consequently, if the power switch is turned off and therefore the CPU 51 is not executing the OS 54E, *the I/O interface 69 executes the jog dial monitor program 70E*, so that pressing the jog dial 4 in the power saving state or when the power to the personal computer 1 is off makes *the same start the processing of a preset predetermined software program or script file.*

The memory card driver 151-1 is connected to the bridge 58 *by a USB cable*. On the basis of commands issued by the CPU 51 and supplied via the bridge 58, the memory card driver 151-1 cross-authenticates the memory card 21-1 loaded in the personal computer 1. Under the control of the CPU 51, the memory card driver 151-1 *stores the music data supplied from the HDD 67, which is an internal storage means, into the authenticated memory card 21-1, which is an external storage medium, via the bridge 58.* (Emphasis Added).

Thus, it is clear from the above-cited portions that when the computer (i.e. the CPU) is off, the memory card drivers 151-1 and 151-2 (which perform write, read, and reproduction functions on a memory card) are powered, the USB interface (which transmits control signals from the jog lever) is powered, and the jog lever itself is powered.

Page 20, lines 18-23 of the specification states:

Under the control of the CPU 51 *or in accordance with a signal inputted from the jog lever 12-1, the memory card driver 151-1* reads the music data from the loaded memory card 21-1, decodes the read music data, and supplies the decoded music data to the sound controller 64. (Emphasis Added).

Thus, this portion suggests that the memory card drivers can perform the same functions under the control of the CPU, or under the control of the jog lever when the CPU is off.

Lastly, page 34, lines 6-15 of the specification states:

When content is written to the memory card 21, the memory card driver 151 encrypts the content by the session key and passes the encrypted content to the memory card 21. The memory card 21 decrypts the encrypted content by the session key, encrypts the decrypted content key by the storage key, and passes the encrypted content key to the memory card driver 151. The storage key is unique to each memory card 21. ***The memory card driver 151 writes the encrypted content key and the encrypted content to the memory card 21.*** (Emphasis Added).

Thus, the above portions of the specification describe that the memory card driver can write encrypted content to the memory card, and thus information can be transferred to the memory card under the control of the memory card driver, USB interface, and jog dial (which are always powered on, even if the CPU is off, as described above).

Consequently, Applicants respectfully submit that the application as originally filed reasonably conveys to the artisan that the inventor had possession of the feature of transferring copyrighted music data to the external storage card even if power of the central processing unit is turned off, and respectfully request that the rejection of Claims 12 and 15-24 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In regard to the objection to the specification, Applicants respectfully submit that the limitation “said power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off and when said external storage card has been cross-authenticated with said general-purpose computer, said external storage card control mechanism transfers copyrighted music data to said

external storage card even if power of said central processing unit is turned off,” has proper support and antecedent basis as described above.

Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

In regard to the objection to the drawings, Applicants respectfully submit that Figure 12 adequately shows the objected to feature recited in Claim 12. Applicants’ Figure 12 shows a flow chart of a content moving process, including steps S14 and S15 which describe that a content key, content, and content additional information data is sent (i.e. transferred) to a memory card (i.e. external storage card). As described above, this process can be performed when the CPU is on or off.

Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

In response to the rejection of Claims 12, 14-19, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi in view of Chan, Applicants respectfully request reconsideration of the rejection and traverse the rejection as discussed next.

Independent Claim 12 is directed to a general-purpose computer including, *inter alia*:

- ...a loading mechanism, which is integrally arranged on a case of said general-purpose computer, for detachably accommodating an external storage card;

- a decoding mechanism configured to decode data read from said external storage card;

- a reproduction mechanism configured to reproduce decoded data decoded by said decoding mechanism;

- a power controller configured to supply power to said general-purpose computer, wherein said power controller supplies power to said decoding mechanism and said reproduction mechanism even if power of said central processing unit is turned off, and said loading mechanism is configured to read said decoded data based on commands from said central processing unit when said general-purpose

computer is in an active state and said loading mechanism is configured to read said decoded data based on commands from an external storage card control mechanism integrally arranged on said case of said general-purpose computer, without control of a central processing unit, when said general-purpose computer is in an inactive state;

a cross-authentication mechanism configured to cross-authenticate said external storage card through said loading mechanism; and

a control mechanism configured to supply copyrighted data read from said external storage card to said reproducing mechanism upon successful cross-authentication by said cross-authentication mechanism *even if power of said central processing unit is turned off,*

*wherein said power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off and when said external storage card has been cross-authenticated with said general-purpose computer, said external storage card control mechanism transfers copyrighted music data to said external storage card even if power of said central processing unit is turned off.*

Chan describes a notebook computer that includes a computer subsystem 104, a CD-ROM subsystem 106, an audio interface IC 102, and a first operating mode in which the computer subsystem is energized and operating, relays commands and data between the digital computer bus 128 of the computer subsystem 104 and the CD-ROM drive 138. In a second operating mode in which the computer subsystem 104 is not energized and is inoperative, the audio-interface IC 102 autonomously responds to signals received from the CD-ROM control buttons and transmits commands to the CD-ROM drive 138 which causes the CD-ROM drive 138 to play an audio CD present in the CD-ROM drive 138.<sup>2</sup> However, Chan fails to teach or suggest that “said power controller supplies power to said cross-authentication mechanism and said control mechanism even if power of said central processing unit is turned off and when said external storage card has been cross-authenticated

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<sup>2</sup> See Chan at column 4, lines 10-20.

with said general-purpose computer, said ***external storage card control mechanism transfers copyrighted music data to said external storage card even if power of said central processing unit is turned off,***” as recited in Applicants’ independent Claim 12.

Chan describes a CD-ROM subsystem 106 which can control the ***reproduction*** of a CD via an audio-interface 102 when the computer subsystem 104 is in an inactive state. However, Chan is directed to the ***control and playing*** of a CD-ROM drive when a computer is in an inactive state, but does not describe transferring data to the CD-ROM. Hence, Chan does not describe an external storage card control mechanism which ***transfers*** music data to an ***external storage card*** when the power of a CPU is turned off.

Page 8 of the outstanding Office Action asserts that “it would have been obvious to the ordinary person skilled in the art at the time of invention that the CD-ROM Drive 138 of Chan would be replaced with the memory card reader/writer 300 and memory card writer slot 501 of Tatebayashi (which is integrally arranged on the case of the personal computer 500 as can be seen in Fig. 2 of Tatebayashi) within the audio subsystem 106, and to have allowed full functionality of the reader/writer when the CPU was not powered, including writing music data to the memory card (Tatebayashi Col. 8 Lines 44-48).

Applicants respectfully disagree and submit that it would not have been obvious for a person of ordinary skill in the art to modify the teachings from these references so as to arrive at Applicant’s claimed inventions. The position that these teachings *could* be modified to arrive at the claimed inventions would be insufficient to establish a prima facie case of obviousness.<sup>3</sup> Furthermore, it is not clear how such modification could be achieved without a substantial reconstruction or redesign of the systems disclosed by these references.<sup>4</sup>

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<sup>3</sup>See MPEP 2143.01 stating that the “fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.”

<sup>4</sup> See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the “suggested combination of references would require a substantial reconstruction and redesign of the elements

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,<sup>5</sup> and by "clear and particular" evidence<sup>6</sup> of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the Tatebayashi device which reads and writes content to a memory card under the control of a CPU by incorporating Chan's CD-ROM player which can play CDs when power of a CPU is off. Without such motivation and absent improper hindsight reconstruction,<sup>7</sup> a person of ordinary skill in the art would not be motivated to perform the proposed modification.

As the CAFC recently commented, "flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.")." <sup>8</sup> In the present case, absent improper hindsight reconstruction based on Applicant's claims, one of ordinary skill in the art would not have found it obvious to construct Applicant's recited device based on the teachings of Tatebayashi and Chan.

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shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

<sup>5</sup> *In re Gartside*, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

<sup>6</sup> *In re Dembiczak*, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." ) (emphasis added).

<sup>7</sup> See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

<sup>8</sup> *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Lab.* 2008 U.S. App. LEXIS 6786 (CAFC, 2008)



Thus, Applicants respectfully submit that amended independent Claim 12 (and all claims depending thereon) patentably distinguishes over Chan. Further, Applicants respectfully submit that Tatebayashi fails to cure the above-noted deficiencies of Chan.

Accordingly, Applicants respectfully request that the rejection of Claims 12, 14-19, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi in view of Chan be withdrawn.

In response to the rejection of Claim 20 under 35 U.S.C. § 103(a) as unpatentable over Tatebayashi and Chan in view of Schneier, Applicants note that Claim 20 is dependent on Claim 12 and is thus believed to be patentable for at least the reasons discussed above. Further, Applicants respectfully submit that Schneier fails to cure any of the above-noted deficiencies of Tatebayashi and Chan.

Accordingly, Applicants respectfully request that the rejection of Claim 20 under 35 U.S.C. § 103(a) be withdrawn.

In order to vary the scope of protection recited in the claims, new Claims 25 and 26 are added. New Claims 25 and 26 find non-limiting support in the disclosure as originally filed, for example at page, 25 line 14 to page 26, line 8.

Therefore, the changes to the claims are not believed to raise a question of new matter.<sup>9</sup>

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<sup>9</sup> See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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